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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,327	01/17/2004	Kasthuri Venkateswaran	CIT002	8321
28848	7590	05/09/2005	EXAMINER	
TOPE-MCKAY & ASSOCIATES 23852 PACIFIC COAST HIGHWAY #311 MALIBU, CA 90265			TONGUE, LAKIA J	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,327

Applicant(s)

VENKATESWARAN ET AL.

Examiner

Lakia J. Tongue

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's response filed on March 3, 2005 is acknowledged. Claim 1 is pending and under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office Action.

Rejections Maintained

Claim 1 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The above rejection is maintained because what is disclosed in the specification does not accurately describe what has been deposited in the Agricultural Research Service Patent Culture Collection (NRRL). The specification and claim recite a pure culture of *Bacillus odysseyi* strain 34hs-1T under accession number of NRRL B-30641^T. However the NRRL depository recites *Bacillus odysseyi* strain 34hs-1 having an accession number of NRRL B-30641. The specification and the claims must reflect what has actually been deposited. The deposit for patent purposes must correspond to the material particularly claimed and disclosed in the specification as filed. See 37 CFR 1.804(a). The requirement for a specific identification is

consistent with the description requirement of the first paragraph of 35 U.S.C 112 and provides an antecedent basis for the biological material which either has been or will be deposited before the patent is granted.

New Grounds of Rejections

Information Disclosure Statement

The information disclosure statement filed 1/14/05 and 2/28/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Applicant has provided parts of the Information Disclosure Statement via the examiner's Right Fax machine, however there are several Non Patent Literature (NPL) documents that were submitted with only the abstract (NPL documents 5-7, 11, 12, 14, 20, 21, 23). Therefore only the abstracts of those documents have been considered. Applicant also submitted book covers, book purchase information and/or titles only for NPL documents 2-4, 10 and 22. The proper text and publication have not been provided therefore those documents have not been considered. NPL documents with lines drawn through them have not been considered, as they have not been

provided. Should Applicant want the NPL documents listed on the IDS to be considered Applicant must provide a full copy of the document.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Venkateswaran, K. et al (*Bacillus nealsonii* sp. nov., isolated from a spacecraft-assembly facility, whose spores are γ -radiation resistant, International Journal of Systematic and Evolutionary Microbiology, July 2002; 53: 165-172).

Claim 1 is drawn to an isolated biologically pure culture of *Bacillus odysseyi* strain 34hs-1T under accession number NRRL B-30641^T.

Venkateswaran et al disclose spore-formers isolated from a spacecraft being that of the genus *Bacillus*. Venkateswaran et al disclose that spores of the bacterial species exhibited resistance to UV, γ -radiation, (H₂O₂) and desiccation. The instant specification characterizes the *Bacillus odysseyi* sp. nov., as round spores that are resistant to Ultra Violet (UV) and gamma radiation, Hydrogen Peroxide (H₂O₂) and desiccation (page 5, section 00035). Aside from the difference in the names of the above strains it is unclear what the differences are between the *Bacillus nealsonii* sp. nov strain, which was isolated from a spacecraft assembly facility and the *Bacillus odysseyi* strain, which was

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isolated from a spacecraft assembly facility. The organisms appear to be the same microorganisms by a different name.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by La Duc, M. et al (Characterization of microbes intimately associated with the Mars Odyssey Orbiter and it's assembly facility, Abstracts of the general meeting of the American Society for Microbiology, 2002; 102: 389).

Claim 1 is drawn to an isolated biologically pure culture of *Bacillus odysseyi* strain 34hs-1T under accession number NRRL B-30641^T.

The instant specification describes *Bacillus odysseyi* sp. nov., as round spores that are resistant to Ultra Violet (UV) and gamma radiation, Hydrogen Peroxide (H₂O₂) and desiccation (page 5, section 00035). La Duc et al disclosed the technical description and admission in the priority document 60/440,790, faxed page 1 and 2 of the above strain at an annual conference. LaDuc cited that several spore-forming isolates were found to possess a plethora of resistances, some of which included resistance to g-radiation, UV, H₂O₂, and desiccation (abstract). The strain of the instant application and the strain of the cited prior art have the same properties.

Since the Office does not have the facilities for examining and comparing applicants' composition with the composition of the prior art, the burden is on applicant to show a novel or unobvious difference between the claimed product and the prior art. See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakia J. Tongue whose telephone number is 571-272-2921. The examiner can normally be reached on Monday-Friday 7-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 571-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LJT
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Patricia A. Duffy
PATRICIA A. DUFFY
PRIMARY EXAMINER